

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Bruce L. Davis

Application No.: 10/086,180

Filed: February 25, 2002

For: DISTRIBUTION AND USE OF
TRUSTED PHOTOS

Examiner: D. Lazaro

Date: June 1, 2007

Art Unit: 2155

Confirmation No.: 1232

Via Electronic Filing

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant requests review of the final rejection of claims 1-15, 27, 28 and 33 in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

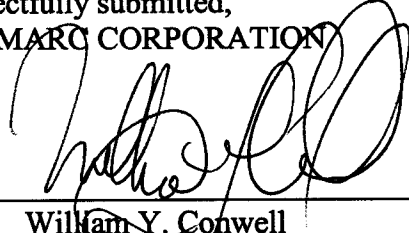
Date: June 1, 2007

Customer Number 23735

Telephone: 503-469-4800
FAX: 503-469-4777

Respectfully submitted,
DIGIMARC CORPORATION

By



William Y. Conwell
Registration No. 31,943
Attorney of Record

PRE-APPEAL BRIEF REQUEST FOR REVIEW

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Board will reverse the rejections. A few reasons for reversal are noted below.

The claims stand rejected as obvious over Dellert (5,760,916) – either alone or in combination with other art.

Dellert is a Kodak disclosure in which a consumer's film is submitted for developing, and Kodak posts digitized counterparts to the exposed pictures on the internet, for access by the consumer.

Consider Appellant's claims 1 and 5, which read:

*1. A method of printing a trusted image, comprising:
an individual user electronically contacting a governmental agency, soliciting an image depicting the user stored in an archive maintained by said governmental agency;
electronically receiving said image from said contacted governmental agency; and
printing a document incorporating said image.*

5. The method of claim 1 in which the governmental agency is a motor vehicle licensing agency, and the image is a driver license photo.

Dellert does not teach, nor suggest, any method involving a governmental agency – as required by claims 1 and 5, and others.

It will be recognized that in Dellert, it is the *consumer* who owns the image. Kodak simply acts as a commercial image service provider – providing services to consumers who are proprietors of their respective images. Dellert teaches providing a consumer with electronic access to images *that the consumer owns*.

In contrast, image archives maintained by governmental agencies are not commercial repositories for images owned by consumers. The images are owned by the government. Nothing in Dellert would have led an artisan to grant access to a consumer to such an archive. Instead, hindsight appears to have guided the rejections.

Such distinctions were disregarded by the Office, which asserts that claim limitations referring to a “governmental agency” should be given no patentable weight. Such limitations were dismissed as “descriptive,”¹ *e.g.*:

said contacted governmental agency. It is desirable to allow users to remotely access images regardless of the type of agency storing those images (Col. 2 lines 11-27). The type of agency/entity is descriptive and does not form a patentable distinction.

7. With respect to Claim 2, Dellert further teaches it is the individual user who

and

9. With respect to Claim 5, Dellert does not explicitly disclose the governmental agency is a motor vehicle licensing agency, and the image is a driver license photo.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The soliciting, receiving and printing would be performed the same regardless of the agency being a motor vehicle licensing agency and the image being a driver license photo. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

“Descriptiveness” is not a ground for ignoring language found in the claim. Indeed, *all* claim limitations necessarily are descriptive – they serve to *describe* the claimed invention.

The Office cited no rule or MPEP policy in support of its action; none is evident.

This is not a case alleged to involve Computer-Related Nonstatutory Subject Matter, *e.g.*, as detailed in MPEP § 2106.01.

As excerpted above, the Office cited the *Gulak* and *Lowry* cases in its rejection. The *Gulak* case does not support the rejection. In that case (which involved claims drawn to information stored on a computer-readable medium), the Federal Circuit *reversed* the Board, and

¹ See, *e.g.*, Final Rejection near the bottom of page 3, and near the top of page 4.

held that the Office *should have given* patentable weight to the descriptive material (stored on the computer-readable medium).

Likewise in *Lowry*: the Federal Circuit *reversed* – holding that the Board erred by denying patentable weight to questioned claim limitations.

In the present case the claims are not drawn to a physical medium, but rather are *method* claims. The claimed acts, e.g., “soliciting” and “receiving,” have no meaning without the nouns and adjectives appearing in the claim. Contrary to the Office’s assertion, such terms are integrally, and functionally, involved in the recited acts. As was the case in *Gulack* and *Lowry*, it was error for the Office to disregard Appellant’s claim limitations.

(In the rejection of independent claim 11, the “at a governmental agency” limitation is not even mentioned.²)

Absent compelling reason, each limitation in a claim must be given meaning. The Office has failed to follow this elementary rule. The Board will recognize such errors and reverse.

Another reason the Board will reverse is because the Office cites Dellert for teachings it does not contain. For example, the Final Rejection of claim 3 states:³

receives said image and prints said document (Col. 9 lines 23-34).

8. With respect to Claim 3, Dellert further teaches said document is a photo identification document (Col. 3 lines 23-49).

Not so. Dellert has no teaching of a photo identification document. The cited passage (lines 23-49 of column 3) reads:

² Final Rejection, paragraph 10, pages 4-5.

³ Final Rejection, paragraph 8, bottom of page 3.

any failure in the system. In particular, the scanner location which was to communicate the images can be contacted to determine if the scanned images were in fact completely communicated to the hub station and if so, the particulars of such transmission, and to request a re-transmission if necessary. Additionally, the presence of a hub station allows a user to forward copies of the images or have other services for the images, consistently obtained from the same location without having to communicate with other vendors and without regard to the locations at which different images may have been scanned.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is block diagram illustrating a system of the present invention;

FIG. 2 is a data flow diagram illustrating the operation of some aspects of the system of FIG. 1;

FIG. 3 is a diagram illustrating the components of an identification generated for an associated image set signal; and

FIG. 4 is a block diagram illustrating a system of FIG. 1 with a further connection of the hub to another hub.

To facilitate understanding, identical reference numerals have been used, where possible, to designate identical elements that are common to the figures.

EMBODIMENTS OF THE INVENTION

In the present invention it will be understood that with

As can be seen, there is no teaching of photo identification documents. (Elsewhere Dellert speaks of using such imagery for greeting cards, or on cups and plates,⁴ but again: nothing is said about photo identification documents.)

The Board will not sustain rejections based on mis-readings of the references.

Additionally, the Board will recognize that the Office has proposed modifications and combinations of art without a suitable rationale for doing so.

Consider the rejection of claim 12 over Dellert + Rhoads. Claim 12 (and claim 11 from which it depends) read as follows:

*11. A method of distributing a trusted image, comprising:
at a governmental agency, receiving an electronic request for an archived personal image from an individual depicted in said image; and
electronically transmitting said image to said individual.*

12. The method of claim 11 that includes processing said image with an identification code prior to said electronic transmission.

⁴ See, e.g., Dellert at col. 9, lines 42-45.

The Final Rejection supports the proposed combination with the following logic:

Application/Control Number: 10/086,180
Art Unit: 2155

Page 7

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is processed with an identification code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads, Col. 7 lines 4-11).

However, claim 11 *does not have any limitation concerning photo identification documents*. Rather, it concerns *fulfilling an individual's request to a governmental agency for an archived personal image, by electronic transmission of an image processed with an identification code*.

The Board will recognize that Office's offered motivation does not support an obviousness rejection of claim 12, as it does not lead to the invention of claim 12.

Because the above-noted defects are sufficient to compel reversal of each of the rejections of the appealed claims, Appellant does not further belabor this paper with other arguments concerning the rejections, the art, and the claims – all of which are reserved for possible presentation to the Board.